

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 156-181 are pending in the application. Claim 157 has been amended. The amendment is fully supported by the original disclosure. No new matter has been introduced. The above amendment were, in many instances, made to clarify Assignee's claims and do not narrow the scope of the amended claims. Furthermore, in many instances, the above amendments broaden the literal scope of claims and/or claim elements. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments.

The rejection of claims 156-181 under 35 U.S.C. 102:

The Examiner has rejected claims 156-179 under 35 USC 3 as being unpatentable over US Patent No. 4,827,508 (hereinafter "Shear") in view of US Patent No. 5,235,641 (hereinafter "Monin"); and has rejected claims 180-181 further in view of US Patent No. 4,588,991 (hereinafter "Atalla"). This rejection is respectfully traversed.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness there must be some suggestion or motivation to modify or combine reference teachings (In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)) which must be found in the prior art and not based on the application disclosure. In re Vaack, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In addition, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). It is submitted that the cited references do not meet these criteria. It is asserted that the Examiner has not established that the proposed combination meets these requirements.

Independent claim 156 recites "supplying to a user at least one of a plurality of utilization permit keys that corresponds only to at least one of different types of uses of the digital data requested by the user, each of the utilization permit keys permitting only the corresponding at least one of the different types of uses of the digital data". Contrary to the assertions of the Office Action, the proposed combination of references does not disclose or suggest this limitation.

The Examiner concedes that "Shear does not disclose the keys corresponding to at least one of different types of uses of digital data requested by the user, each of the utilization permit keys permitting only the corresponding at least one of the different types of uses of the digital data." See page 3 of the current Office Action. The Examiner attempts to cure Shear of this failure through combination with

Monin. Assignee respectfully submits the Examiner has failed to establish that Monin cures Shear of this failure.

Specifically, the Examiner asserts that Monin "discloses the keys corresponding to at least one of different types of uses of digital data requested by the user (column 3 line 40 to column 4 line 10)... [t]he keys allow access to a specific type of digital data (column 5 line 42-56)." First, Assignee submits that whether or not Monin discloses keys allowing "access to a specific type of digital data" (as stated by the Examiner) is irrelevant to independent claim 156. Second, Assignee can find no support in column 3 line 40 to column 4 line 10 of Monin for the Examiner's contention that Monin "discloses the keys corresponding to at least one of different types of uses of digital data requested by the user". Rather, Monin discusses sending signals ES (encrypted signal from scrambler 5), KS (output of key generator 6), and DS (program entitlement data from circuit 7) as combined to constitute signal BS (broadcast signal). Thus, the Examiner has not established that Monin teaches or suggests "...a *plurality of utilization permit keys that corresponds only to at least one of different types of uses...*" as recited in independent claim 156.

For at least this reason, it is submitted that the Examiner has failed to establish that the proposed combination of references renders obvious all of the features of claim 156.

Claims 157-168 are likewise not obvious, due at least to their dependence on claim 156.

Claims 169-181 are similarly not obvious, at least on the same or similar basis as claim 156.

It is noted that other bases for traversing the rejection could be provided, but it is believed that this ground is sufficient. It is therefore respectfully requested that the obviousness rejection of claims 156-181 be withdrawn.

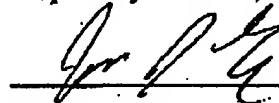
CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439.6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3130.

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Respectfully submitted,



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